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Paper No. 16

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TECHNOLOGY CENTER 2100

In re Application of: McKean et al. )  
Application No. 09/671,002 )  
Attorney Docket No. SJ0920000068US1 ) **DECISION ON PETITION TO**  
Filed: September 27, 2000 ) **WITHDRAW HOLDING OF**  
For: METHOD AND APPARATUS FOR ) **ABANDONMENT UNDER 37 CFR**  
MIGRATING DATA HAVING A FORMAT ) **§1.181**  
OF A FIRST TYPE TO A FORMAT OF A )  
SECOND TYPE )

This is a decision on the renewed petition, filed October 2, 2003, by Mr. David W. Lynch requesting the Withdrawal of the Holding of Abandonment of the above-identified application. The petition is being considered under 37 CFR §1.181. This application was held abandoned for failure to respond to the Final Rejection mailed September 24, 2002 (Paper No. 8). A Notice of Abandonment was mailed on May 6, 2003 (Paper No. 11). The original petition was dismissed because it was not clear the evidence provided by the practitioner was for the address of record at the time of mailing of the Office action.

In support of the current petition for reconsideration, Mr. Lynch provides statements that the Office action was not received; that the practitioners filed no change of address on April 14, 2002; and that an address change to Customer Number 22865 was caused by Office error. The renewed petition does not discuss for which address the evidence originally submitted on June 10, 2003 was provided.

**Applicable Prosecution History**

Sep 27, 2000	Original declaration and power of attorney filed
Jan 12, 2001	Change of address filed (Paper No. 2)
Apr 25, 2002	First action on the merits mailed (Paper No. 4)
Apr 14, 2002	Customer No. 22865 established for this application and change of address and change to powers of attorneys made (determined by reviewing PALM records)
May 14, 2002	Change of address and power of attorney paper matched to application (see Paper No. 5)

Jul 5, 2002	Amendment filed (Paper No. 6)
Sep 24, 2002	Final rejection mailed (Paper No. 8)
Mar 24, 2003	Six-month period for reply expired
Apr 23, 2003	Change of address filed in response to examiner query. Address submitted is duplicate of January 12, 2001 filing
May 6, 2003	Notice of abandonment mailed (Paper No. 11)
Jun 10, 2003	Petition to withdraw holding of abandonment filed
Jul 18, 2003	Change of address filed (Paper No. 14)
Jul 29, 2003	Petition decision mailed (Paper No. 13)

#### **Issues involving Address Changes**

Unraveling this file's address changes and powers of attorney is complicated by the practitioners' use of a customer number to make changes to applications they are prosecuting. In addition, different practitioners have drafted the original petition (Mr. Lasky) and the renewed petition (Mr. Lynch) along with an apparent shift in the firms responsible for prosecuting this application. Finally, an attempt by Mr. Lynch to change the address in July 2003 crossed in the mail with the petition decision mailed July 29, 2003.

Mr. Lynch has made an unsubstantiated statement regarding an Office error made around May 2002 to the address associated with customer number 22865. At an unspecified date, the attorneys of record discovered the "unauthorized update of the address for customer number 22865." This unauthorized update was made to "many such files." Mr. Lynch further states that "previous petitions for other applications have been denied, but later accepted...". The type of petitions and who was the deciding official in the accepted petitions is left to the imagination. The practitioner mentions Mr. Scherbel, but as Mr. Scherbel is a supervisory patent examiner (SPE), it is unclear as to how Mr. Scherbel became involved and in what capacity he resolved these cases. A supervisory patent examiner is not normally involved in solving a problem affecting many applications across the Office for applicants, but rather, may help in isolated files before their art unit. Clarification of these various statements is requested.

What evidence the Office does have is found in the file wrapper and in the electronic database for applications, PALM. On September 27, 2000, a valid declaration appointed Mr. Lynch and Altera Law Group (which included Mr. Lasky) at the address of 10749 Bren Road East, Opus 2, Minneapolis, MN 55343. A change of address, filed by Mr. Lynch on January 12, 2001 changed the correspondence address to Altera Law Group at 6500 City West Parkway, Minneapolis MN 55344. Around April 14, 2002, it appears from the Office's electronic records (PALM), that the Altera Law Group established a customer number for it applications. A change of address/power of attorney paper was matched to the application on May 14, 2002 that re-established the Bren

Road address and listed the practitioner numbers for customer number 22865 as 29555, 36204, 37674, 37830 and 40337 only. Mr. Lynch's number is 36204 and Mr. Lasky's number is 29555; therefore, both practitioners remained of record. It is noted that papers filed by the practitioners after May 2002 bear the Customer Number 22865.

The paper submitted via fax on April 23, 2003 was labeled as a copy of the change of correspondence address filed in January 2001. It carried the bar code for customer number 22865 and was signed by Mr. Lynch. Mr. Lynch transmitted no separate instructions in the cover letter. In hindsight, it appears Mr. Lynch was signaling the Office that the proper address should have been 6500 City West Parkway, but no specific instructions to that effect were given. As the address had been established via customer number, the Office did not revert to the 2001 address based upon Mr. Lynch's letter.

The following guidelines were set forth in the Official Gazette Notice, 1191 OG 187, "Extension of the Payor Number Practice (through 'Customer Numbers') to Matters Involving Pending Patent Applications" dated October 15, 1996.

As the PTO will not recognize more than one correspondence address (37 CFR 1.34(c)), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application would be resolved in favor of the address of the Customer Number. Where an applicant appoints all of the practitioners associated with a Customer Number as well as a list of individually named practitioners such action would be treated as only an appointment of all of the practitioners associated with a Customer Number due to the potential for confusion and data entry errors in entering registration number from plural sources.

Essentially, Mr. Lynch could not correct the correspondence address via separate letter once the customer number was established for this application. Any changes to the correspondence address would need to be made by updating the information associated with the customer number.

The practitioners are invited to provide copies of the information submitted to the Office at the time the customer number was established for this application to determine whether the Office in fact made a mistake. Absent a showing by the practitioners that an Office error occurred in the establishment of the correspondence address associated with Customer Number 22865; the address is presumed to be correct, Mr. Lynch's statements notwithstanding.

A review of the electronic database indicates Customer Number 22865 is no longer associated with this application. The practitioners should provide evidence as to when and how this change occurred. For purposes of this petition decision, the address of 6500 City West Parkway, Suite 100 will be used, but it now appears that the change of address accepted April 30, 2003 should not have been accepted unless the address was updated for the customer number. That issue is moot in regards to whether the Final Rejection was mailed to the "proper address" since the mail date of the Final Rejection was September 24, 2002.

Additionally, the Office's electronic records show that Mr. Lynch no longer is a practitioner of record for Customer Number 22865. Mr. Lasky signed the first petition in June 2003 while Mr. Lynch has signed the latest petition. Therefore, pending resolution of who has the power of attorney in the file, this decision is being mailed to the firm associated with Customer Number 22865. As Mr. Lynch no longer is a practitioner of record for that Customer Number, he is not

authorized to submit a change of correspondence paper (see MPEP § 405). Therefore, the paper submitted July 18, 2003 has not been processed.

**Issues Involving Nonreceipt of Correspondence**

All of this is still secondary as to the proof necessary set forth in MPEP §711.03(c), the showing required to establish nonreceipt of an Office action includes the following:

- 1) *a statement from **the practitioner** that the Office action was not received,*
- 2) *a statement from **the practitioner** that the file jacket and docket records were searched,*
- 3) *a **copy of the docket record at the address of record, and***
- 4) *a reference to the docket record in the practitioner's statement.*

[Emphasis added.]

The petition fails to fully comply with the requirements set forth above. The evidence submitted to date has not overcome the presumption of receipt.

At this point, it is not clear who was the practitioner at the time of the mailing of the Final Rejection in September 2002. As Mr. Lasky filed the original petition and made the original practitioner's statements, it is not clear he is the attorney who should have even been making the statements. Did he have access to Mr. Lynch's records at the time the statements were being made? To what address were the records addressed which were reviewed?

The evidence requested in the original petition decision is still requested: specifically a **listing** in accordance with the practitioner's normal record-keeping regarding incoming correspondence and the practitioner's tracking of due dates relating to this particular application. If the practitioner does not keep such a docketing record, the practitioner should make a statement addressing his normal record-keeping practices and how files are maintained in his office. Specifically needed are statements regarding how incoming mail is recorded and how deadlines are tracked. To date, the practitioner's evidence only shows the missing paper was not found in a file. The possibility remains the practitioner received the Final Rejection, but may have lost it later. Any statements must be for the address of record and by the practitioner responsible for the application at the time of the mailing of the Final Rejection.

The petition is **DISMISSED**.

Petitioners are being granted one additional opportunity to resolve the issues raised in this decision within two (2) months of the mailing date of this decision. No further submissions will be accepted after that. In the alternative, the petitioners may wish to consider filing a petition to revive under 37 CFR 1.137. Telephone inquiries should be directed to the undersigned at (703) 308-0269.



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